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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,037	12/10/1999	MASASHI HAMADA	1232-4604	9614

27123 7590 05/20/2005

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EXAMINER

BEAMER, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/459,037	HAMADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Temica M. Beamer	2681	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 63-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 4/25/2005 have been fully considered but they are not persuasive.

Applicant argues that Frager et al (Frager) fails to disclose the limitations of independent claims 63, 65 and 67. Specifically, the applicant argues that Frager fails to teach all of the limitations of the independent claims in a single mobile terminal, but rather teaches some of the limitations on the network side and some on the mobile terminal side. Applicant further states that the phrase "mobile terminal" in the preamble is necessary to "give life, meaning and vitality" in independent claim 63 and also in independent claims 65 and 67.

The examiner, however, partially agrees. Regarding independent claim 63, the phrase "mobile radio terminal comprising" in the preamble does need to be given patentable weight because according to MPEP Section 2111.02, the phrase limits the structure of the apparatus. However, for independent claim 65, the preamble does not have to be given patentable weight because it merely recites the intended use of a structure (i.e., a mobile terminal). As such, the body of claim 65 does not depend on the preamble for completeness and therefore is able to stand alone (MPEP Section 2111.02). Such reasoning is also given for independent claim 67.

Therefore, based on the remarks above, the rejections of claims 63-68 are set forth below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 65-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Frager et al (Frager), U.S. Patent No. 6,018,652.

Regarding claims 65 and 67, Frager discloses receiving means for receiving data related to a communication charge from a first carrier (col. 5, line 65-col. 6, line 23); calculating means for calculating the communication charge for the first carrier in accordance with the data received by said receiving means (col. 6, lines 38-48; switching means for switching from the first carrier to a second carrier during communication in the first carrier (col. 6, line 66-col. 7, line 23) and storing means for storing the communication charge calculated by said calculating means, wherein the communication charge is based on the time until the first carrier is switched to the second carrier after the communication is started (col. 6, lines 38-48).

Regarding claims 66 and 68, Frager discloses wherein said storing means stores communication start time for the second carrier as evidenced by the fact

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that the system keeps accurate records of when charging rates change for a mobile station that has moved to a new charging area (col. 6, lines 38-48).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frager in view of Steijer, U.S. Patent No. 6,408,174.

Regarding claim 63, receiving means for receiving data related to a communication charge from a first carrier (col. 5, line 65-col. 6, line 23); calculating means for calculating the communication charge for the first carrier in accordance with the data received by said receiving means (col. 6, lines 38-48; switching means for switching from the first carrier to a second carrier during communication in the first carrier (col. 6, line 66-col. 7, line 23) and storing means for storing the communication charge calculated by said calculating means, wherein the communication charge is based on the time until the first carrier is switched to the second carrier after the communication is started (col. 6, lines 38-48).

Frager, however, fails to disclose wherein all of these functions are performed in a single mobile device.

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In a similar field of endeavor, Steijer discloses a single mobile device which has means to receive charge information from different systems, calculating means for calculating charges from different systems (col. 3, line 35-col. 4, line 14), switching means for switching between different systems (as evidenced by the fact that multiple base stations in different geographical areas are provided, col. 3, lines 10-34; figure 3) and storing means for storing calculated charges (col. 3, line 35-col. 4, line 14).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Frager with the teachings of Steijer for the purpose of saving system resources by having a single device to perform critical functions (see Steijer, col. 3, lines 44-47).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Beamer whose telephone number is (571) 272-7797. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 7:00am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Beamer  
Primary Examiner  
Art Unit 2681

May 16, 2005



TEMICA BEAMER  
PRIMARY EXAMINER